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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,537	12/19/2003	Gary A. KNEEZEL	117003	1536
27074	7590	01/12/2007	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			ARANCIBIA, MAUREEN GRAMAGLIA	
			ART UNIT	PAPER NUMBER
			1763	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/12/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/12/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/707,537	Applicant(s) KNEEZEL, GARY A.	
	Examiner Maureen G. Arancibia	Art Unit 1763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 4-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,234,623 to Drake.**

In regards to Claims 1 and 2, Drake teaches a method of manufacturing an internal filter, comprising: providing a first substrate 31; providing a second substrate 28; forming a plurality of first passages 45 in the first substrate using an orientation-dependent etching technique (Column 3, Lines 55-62; Column 5, Lines 11-26); forming a plurality of second passages 56 in the first substrate using an orientation-dependent etching technique (Column 3, Lines 55-62; Column 5, Lines 11-26); forming a plurality of third passages 60 in the second substrate (*in top layer 18*) using an etching technique (Column 4, Lines 34-46; Column 5, Lines 33-43); and placing the first and second substrates adjacent to each other (Column 4, Lines 47-56; Column 5, Lines 45-53), such that the plurality of third passages extend between the first passages and second passages and fluidly connect the first and second passages such that particles having a size greater than that which can pass through the third passages are filtered from the fluid when the fluid flows through the first passages, into and through the third passages and into the second passages (Column 4, Lines 35-67; Figures 2 and 3).

It is noted that contrary to Applicant's argument, Drake teaches that a *plurality* of first passages 45 and a *plurality* of second passages 56 are formed in the first substrate for the provision of a plurality of printheads. The first substrate 31 and second substrate 28 are aligned and bonded *before* the substrates are diced to produce the plurality of individual printheads. (Column 2, Lines 17-31) Thus, Drake meets the limitations of Claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drake in view of U.S. Patent 4,612,554 to Poleshuk (previously of record).**

The teachings of Drake were discussed above.

In regards to Claim 3, Drake does not expressly teach that third passages 60 are formed by orientation-dependent etching.

Drake does teach that second substrate 28, on which are formed heating elements 34 and electrodes 33, is formed of silicon (Column 4, Lines 4-6; Column 5, Lines 34-36), and that orientation-dependent etching is used to etch tapered passages 55 (Figure 2) in a silicon substrate 31. (Column 3, Lines 55-62; Column 5, Lines 11-26) Drake further teaches that it is preferable for both filter arrays (i.e. first passages 55 and third passages 60) to have substantially the same pore size (Column 4, Lines 57-58)

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Poleshuk teaches that tapered passages 29 can be etched directly into silicon substrate 28 using orientation-dependent etching; while flat lands of the substrate hold heating elements 30 and electrodes 33. (Figures 5 and 6; Column 10, Lines 17-34)

It would have been obvious to one of ordinary skill in the art to modify the method taught by Drake to form third passages 60 by direct orientation-dependent etching of silicon substrate 28, with the heating elements and electrodes being formed on the flat lands of the silicon substrate, as taught by Poleshuk. The motivation for making such a modification would have been that by applying the teachings of Poleshuk, the same orientation-dependent etching technique would be used to form passages 60 and passages 55 of Drake, and thereby both filter arrays (first passages 55 and third passages 60) could easily be formed to have the same size (since they would be of the same tapered shape), in order to filter out particulates or contaminants from the fluid. (Drake; Column 4, Lines 47-67).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/707,535 ('535) (which claim has been allowed, but not yet issued).

Although the conflicting claims are not identical, they are not patentably distinct from each other because while Claim 1 of '535 is a product claim, it recites all of the limitations of Claims 1-3 of the instant application substantially as claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's remaining arguments have been considered but, where not addressed above, are moot in view of the new ground(s) of rejection.

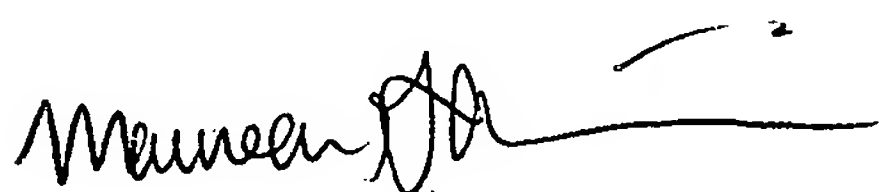
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen G. Arancibia whose telephone number is (571) 272-1219. The examiner can normally be reached on core hours of 10-5, Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on (571) 272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maureen G. Arancibia
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